

REMARKS

In the Office Action identified above, the Examiner rejected claims 1-26 under 35 U.S.C. § 102(e) as anticipated by Cochran (U.S. Patent No. 5,995,979); and rejected claims 19-20 and 25 as being unpatentable over Brunner et al. (U.S. Patent No. 5,995,971) in view of Cochran. Based on the following reasoning, Applicant respectfully traverses the Examiner's rejections under 35 U.S.C. § 102 and § 103(a).

I. The Rejection of Claims 1-26 Under 35 U.S.C. § 102(e).

Claims 1-26 were rejected under 35 U.S.C. § 102(e) as being anticipated by Cochran. Applicant respectfully traverses this rejection.

In order to support a rejection under 35 U.S.C. § 102(e), each and every element as set forth in the claims must be found, either expressly or inherently described, in a single prior art reference. M.P.E.P. § 2131. Cochran fails to teach each and every recitation of claims 1-26.

Claim 1 recites “[c]omputer apparatus for information retrieval” including, *inter alia*, “information storage accessible through the bus and containing stored information” and “a processor connected to said bus, said processor configured to receive search queries over said communications interface, to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information.”

These elements of claim 1 are in no way disclosed or suggested by Cochran. The Examiner states on page 3 of the Office Action that “Cochran has shown the claimed limitations of ‘information storage accessible through the bus and containing stored information’ as a CD-ROM (See Cochran Col. 5, lines 39-41) and it is also apparent that

the CD-ROM would be connected to a bus to properly function with the processor.” The Examiner further states:

[i]n particular, claim 1 recites a processor ‘to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information.’ Cochran discloses the aforementioned claimed limitation by providing a method for managing the presentation of search terms on a computer wherein multiple lists of search terms are displayed, a search is conducted based upon selected search terms from one or more of the multiple search lists, also, the records identified by the search is used to form new lists of search terms (See Cochran Abstract, Col. 4, lines 1-57, Figure 2 and corresponding text).

This, however, is not a teaching or suggestion of at least an “information storage accessible through the bus and containing stored information” and “a processor connected to said bus, said processor configured to receive search queries over said communications interface, to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information,” as recited in claim 1 (emphasis added). That is, the Examiner has failed to show where “a list of terms used in the search queries presented over a period of time” are selectively added to the stored information (i.e., the data stored in the CD-ROM of Cochran, which the Examiner interpreted as the “stored information”). Applicant therefore requests the Examiner to withdraw the rejection of claim 1.

These deficiencies in the teachings of Cochran are further shown on pages 14-15 of the Office Action, where the Examiner states:

The Examiner respectfully submits that because Cochran shows that (1) a search of the database is conducted based upon selected search terms” (2) “subset of records identified by the search is used to form new list of search terms” and (3) “the matching records or hits are stored at the server 710” is a clear indication that Cochran discloses the claimed features of “to process the search queries against the stored information, and to provide a list of terms used in the search queries presented over a period of time to be selectively added to the stored information” as well as “providing search access to the stored items in response to search queries submitted by users, the server configured to provide a list of terms used in the search queries over a period of time to

be selectively added to at least one of the stored items.”

Thus, the Examiner’s statements that “... subset of records identified by the search is used to form new list of search terms” and “the matching records or hits are stored at the server ...” clearly show that contrary to the Examiner’s assertions, Cochran fails to teach or disclose “a list of terms used in the search queries presented over a period of time” are selectively added to the stored information,” as recited in claim 1.

Claim 4, although of different scope, recites elements similar to that discussed above with regard to claim 1. Applicant therefore requests the Examiner to withdraw the rejection of claim 4 for at least the same reasons discussed above with respect to claim 1.

Claims 2-3 and 5-6 depend from claims 1 and 4, respectively. As explained, claims 1 and 4 recite elements not disclosed by Cochran. Accordingly, claims 2-3 and 5-6 are allowable over Cochran for at least the same reasons as claims 1 and 4. Applicant therefore respectfully requests that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Claim 7 recites “[a] method of enhancing information retrieval in an information retrieval system” including, *inter alia*, “storing a list of queries submitted to a search engine” and “selecting at least a portion of relatively high frequency search terms and processing each search term of the portion for selective addition to documents or files stored in the system as a meta-tag.”

These elements of claim 7 are in no way disclosed or suggested by Cochran. The Examiner states on page 6 of the Office Action:

Cochran discloses the claimed feature of ‘ (sic) providing an element for storing list of queries’ and ‘an element for storing a list terms’ by providing memory spaces for \ retaining search request (See Cochran Col. 6, lines 40-52).” The Examiner further states that “Cochran discloses the claimed limitations of ‘processing each term of said

portion for selectively addition to documents or files stored in said systems as a meta-tag' by allowing entry to be made in the lists, thus, updating the lists (See Cochran Col. 12, lines 54-56).

This, however, is not a teaching or suggestion of at least "storing a list of queries submitted to a search engine" and "selecting at least a portion of relatively high frequency search terms and processing each search term of the portion for selective addition to documents or files stored in the system as a meta-tag," as recited in claim 7 (emphasis added). That is, even if the cited portions disclose updating "lists of search terms" they fail to teach or suggest "selecting at least a portion of relatively high frequency search terms and processing each search term of the portion for selective addition to documents or files stored in the system as a meta-tag," as recited in claim 7. Applicant therefore requests the Examiner to withdraw the rejection of claim 7.

Furthermore, Cochran also fails to teach "storing a list of search terms ... with frequency of occurrence" and "selecting at least a portion of relatively high frequency search terms," as recited in claim 7. Therefore for these additional reasons, the rejection of claim 7 is improper and should be withdrawn. On page 17 of the Office Action, the Examiner states "[s]ince Cochran selected, processed and added all the terms and Cochran did not make any distinction between the higher and lower term frequencies; therefore, at one point in Cochran the highest term is selected, processed and added to the lists." However, it is clear from the Examiner's statement that "[] Cochran did not make any distinction between the higher and lower term frequencies" that the Examiner has failed to show that Cochran teaches or suggests "storing a list of search terms with frequency of occurrence," as recited in claim 7.

Claims 8-12 depend from claim 7. As explained, claim 7 recites elements not disclosed by Cochran. Accordingly, claims 8-12 are allowable over Cochran for at least the same reasons as claim 7. Applicant therefore respectfully requests that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Claim 13, although of different scope, recites elements similar to that discussed above with regard to claim 7. Applicant therefore requests the Examiner to withdraw the rejection of claim 13 for at least the same reasons discussed above with respect to claim 7.

Claim 14 recites “[a] method of enhancing information retrieval in an information retrieval system ” including, *inter alia*, “using the master term list and the new term list as a source of terms for adding to documents containing the terms as a meta-tag.”

This element of claim 14 is in no way disclosed or suggested by Cochran. The Examiner states on page 8 of the Office Action that “all the limitations of this claim have been noted in the rejection of claims 1-12.” However, as explained above, the cited portions of Cochran fail to teach or suggest “using the master term list and the new term list as a source of terms for adding to documents containing the terms as a meta-tag,” as recited in claim 14 (emphasis added). Applicant therefore requests the Examiner to withdraw the rejection of claim 14 .

Furthermore, Cochran also fails to teach “using the master term list and the new term list as a source of terms,” as recited in claim 14. Therefore for this additional reason, the rejection of claim 14 is improper and should be withdrawn.

Claims 15-17 depend from claim 14. As explained, claim 14 recites elements not disclosed by Cochran. Accordingly, claims 15-17 are allowable over Cochran for at least

the same reasons as claim 14. Applicant therefore respectfully requests that the rejection of these claims under 35 U.S.C. § 102(e) be withdrawn and the claims allowed.

Claim 18, although of different scope, recites elements similar to that discussed above with regard to claim 7. Applicant therefore requests the Examiner to withdraw the rejection of claim 18 for at least the same reasons discussed above with respect to claim 7.

Claim 19 recites “[a] method of assisting a user indexing a document created by the user ” including, *inter alia*, “adding the received terms to a document as a meta-tag.”

This element of claim 19 is in no way disclosed or suggested by Cochran. The Examiner states on page 9 of the Office Action that “most of the limitations of these claims have been noted in the rejection of claims 1-12.” However, as explained above, the cited portions of Cochran fail to teach or suggest “adding the received terms to a document as a meta-tag,” as recited in claim 19 (emphasis added). Applicant therefore requests the Examiner to withdraw the rejection of claim 19 .

Claim 20 recites “[a] method of enhancing information retrieval in a system containing stored documents ” including, *inter alia*, “determining if the stored document contains subject matter related to the term” and “selectively adding the term to the document as a meta-tag.”

These elements of claim 20 are in no way disclosed or suggested by Cochran. The Examiner states on page 9 of the Office Action that “most of the limitations of these claims have been noted in the rejection of claims 1-12.” However, as explained above, the cited portions of Cochran fail to teach or suggest “determining if the stored document contains subject matter related to the term” and “selectively adding the term to the document as a

meta-tag," as recited in claim 20 (emphasis added). Applicant therefore requests the Examiner to withdraw the rejection of claim 20.

Claim 21, although of different scope, recites elements similar to that discussed above with regard to claims 19 and 20. Applicant therefore requests the Examiner to withdraw the rejection of claim 21 for at least the same reasons discussed above with respect to claims 19 and 20.

Claim 22 depends from claim 21. As explained, claim 21 recites elements not disclosed by Cochran. Accordingly, claim 22 is allowable over Cochran for at least the same reasons as claim 21. Applicant therefore respectfully requests that the rejection of this claim under 35 U.S.C. § 102(e) be withdrawn and the claim allowed.

Claims 23-26, although of different scope, recites elements similar to that discussed above with regard to claims 7, 14, 19, and 21, respectively. Applicant therefore requests the Examiner to withdraw the rejection of claims 23-26 for at least the same reasons discussed above with respect to claims 7, 14, 19, and 21.

II. The Rejection of Claims 19, 20, and 25 Under 35 U.S.C. § 103(a).

Claims 19, 20, and 25 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Brunner et al. in view of Cochran. Applicant respectfully traverses this rejection because the Examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, the prior art reference (or references when combined) must teach or suggest all the claim elements. Furthermore, "[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art." See M.P.E.P. § 2143.01 (8th Ed., Aug. 2001), quoting *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970).

Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify a reference or to combine reference teachings. Finally, there must be a reasonable expectation of success. See M.P.E.P. § 2143 (8th Ed. 2001), pp. 2100-122 to 127.

Claim 19 recites “[a] method of assisting a user indexing a document created by the user ” including, *inter alia*, “adding the received terms to a document as a meta-tag.”

Indeed as the Examiner has acknowledged, Brunner et al. fails to teach or suggest at least this element of claim 1. See Office Action, page 10, ¶ 2. The Examiner therefore cited Cochran in further support of the § 103 rejection.

However, Cochran does not cure the deficiencies of Brunner et al. That is, as explained above, Cochran also fails to teach or suggest “adding the received terms to a document as a meta-tag,” as recited in claim 19.

Furthermore, the Examiner states that “[a]s to the aspect of adding as meta-tag. Cochran provides mechanism that allows terms added in the list to be viewed or access as meta-tag because FIG. 3b shows a list of search terms 211 that is displayed if the user expands pick box 311 corresponding to the first list identifier 111” The Examiner further states:

[t]he most important part of the description of Figure 3b, in another to understand the teachings of Cochran with respect to meta tag or information, is a list of search terms 211 that is displayed if the user expands pick box 311 corresponding to the first list identifier 111 (Start of Travel). In this case, the first list identifier 111 (Start of Travel) is the data that describes meta-data list of search terms 211 because when Start Travel is selected the meta-data for a corresponding list of search terms are displayed within the travel search database window.

This, however, is not a teaching or suggestion of at least an “adding the received terms to a document as a meta-tag,” as recited in claim 19. That is, even if the cited

portions disclose lists of search terms they fail to teach or suggest "adding the received terms to a document as a meta-tag," as recited in claim 19. Applicant therefore requests the Examiner to withdraw the rejection of claim 19.

For at least these reasons, Brunner et al. and Cochran fail to teach each and every element of claim 19. Accordingly, Applicant respectfully requests that the rejection of claim 19 under 35 U.S.C. § 103(a) be withdrawn and the claim allowed.

Claims 20 and 25, although of different scope, recite elements similar to that discussed above with regard to claim 19. Applicant therefore requests the Examiner to withdraw the rejection of claims 20 and 25 for at least the same reasons discussed above with respect to claim 19.

III. Conclusion

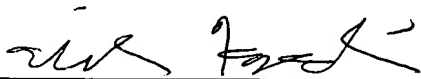
In view of the foregoing remarks, Applicant submits that this claimed invention, is neither anticipated nor rendered obvious in view of the prior art references cited against this application. Applicant therefore requests the Examiner's reconsideration and reexamination of the application, and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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